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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/712,182

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Merrill Brooks Smith

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EXAMINER

TRAIL, ALLYSON NEEL

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/712,182	Applicant(s) SMITH, MERRILL BROOKS	
	Examiner Allyson N. Trail	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-45 and 47-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11,13-38,40-45 and 47-64 is/are rejected.
- 7) ☒ Claim(s) 12 and 39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the Amendment filed November 25, 2005.

Claim Objections

2. Claims 47 and 48 are objected to because of the following informalities:

Both claims 47 and 48 currently depend on cancelled claim 46.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3-10, 13-38, 40-45, 47-49, and 51-64 are rejected under 35 U.S.C. 102(e) as being anticipated by Stoutenburg et al (2003/0222135).

With respect to claims 1, 14, 34, 38, and 59, Stoutenburg et al teach a point of sale (POS) device 130, which is able to read bar codes. The bar codes identify products and the bar code reader transfers the information to a central database.

Stoutenburg et al further teach printing bar codes on receipts, which in turn are associated with a product or service that was sold to the customer. (Paragraph 0088).

More specifically, Stoutenburg et al teach purchasing a prepaid phone card from a point of sale terminal. Discussed in paragraphs 0153-0158, Stoutenburg et al disclose choosing a certain prepaid phone card, swiping that phone card through the (POS) card reader, issuing the prepaid card to the customer, and providing a printed PIN to the customer that is associated with the purchased prepaid calling card.

With respects to claims 1, 14, 34, 38, and 59 the prepaid phone card is considered the keycard. The chosen phone card is selected by the customer from a plurality of available phone cards. The phone card (keycard) is associated with a product identification number – the actual account number stored in the central database. The product identification number is input from the phone (key) card at the POS terminal. The ID number is transmitted from the POS terminal to a central processor. A transaction confirmation from the central processor is received at the POS terminal and the confirmation is associated with the account or production ID number.

With respect to claims 3, 15, 35, 40, and 52-58, Stoutenburg et al teach issuing a printed PIN, which is associated with the prepaid calling card. “In addition, the new value account can be marked as active and a PIN for accessing the new value account using the card can either be mailed to the customer at a provided address, or provided immediately to the customer via

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POS device 130. Where the PIN is provided to the customer via POS device 130, it is transferred to POS device 130 via communication network 120, and a receipt printed and provided to the customer using a roll printer associated with POS device 130.” (Paragraph 0157).

As discussed above, with respect to claims 4, 13, 16, 21, 22, and 37, Stoutenburg et al teach the PIN being associated with a prepaid calling card. The customer is made aware that the PIN is used in association with the card.

With respect to claims 5, 6, 17, and 18, Stoutenburg et al teach the various stored value cards including barcodes for storing an identifier. (Paragraph 0130). As discussed above, Stoutenburg et al teach the POS terminal including a barcode reader for reading stored identifiers.

With respect to claims 7 and 19, Stoutenburg et al teach in paragraph 0130 the stored value card additionally being capable of storing identification information in the form of a magnetic strip.

With respect to claims 9, 10, 14, and 20, Stoutenburg et al teach associating the phone card with a specific provider and a specific value. Paragraph 0148 discusses the customer choosing the amount of stored value and the merchant entering that amount in the POS terminal. Starting in paragraph 0140, it is disclosed how the phone card is associated with a specific provider.

With respect to claims 8, 23-33, 41-45, and 54-58, Stoutenburg et al teach a stored value card being associated with multiple varieties. Stoutenburg et al specifically teaches gift cards, phone cards, prepaid credit cards, however also

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teaches that any variety of cards are possible and is not limited. (Paragraph 0135).

With respect to claims 36, 51, 59, and 60, Stoutenburg et al teach changing the value of a stored value account. (Paragraph 0147).

Additionally, as discussed above, Stoutenburg et al teach printing bar codes on receipts, which in turn are associated with a product or service that was sold to the customer. (Paragraph 0088).

With respect to claim 47, Stoutenburg et al teach adding the associated stored value to the customer account. (Paragraph 0147).

With respect to claim 48, Stoutenburg et al further discloses providing the customer with a card (provider identifier), which can be used to add value to the account. (Paragraph 0147).

With respect to claim 49, Stoutenburg et al teach establishing communication between the customer and the communications provider. The communication provider (calling card company) establishes the communication with the customer.

With respect to claim 61, Stoutenburg et al teach the merchant terminal being a terminal of a merchant (the POS terminal), and the phone card (keycard) is associated with a specific provider (the phone company). The phone company is a different entity from the merchant.

With respect to claim 62, as is discussed above Stoutenburg et al teach the provider (phone company) providing the product to the merchant (retail

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establishment, which includes the POS terminal). The merchant actually distributes the product (phone card and PIN) to the customer.

With respect to claims 63 and 64, also discussed above, Stoutenburg et al teach associating the keycard with a product identification number and a product prior to the act of receiving the request.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stoutenburg et al (2003/0222135) in view of Davila et al (2004/0046035).

Stoutenburg et al's teachings are discussed above. Stoutenburg et al however fails to specifically teach the merchant selecting the keycard from among a set of keycards affixed to a device.

With respect to claim 11, Davila et al teach retailers displaying multiple stored value cards.

In view of Davila et al's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to display the prepaid calling cards taught by Stoutenburg et al in a similar fashion to the displayed stored value cards, which is taught by Davila et al. One would be motivated to

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display the cards, the both the merchant and the customer are able to see the variety of prepaid cards available.

7. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stoutenburg et al (2003/0222135) in view of Karns et al(2004/0267663).

Stoutenburg et al's teachings are discussed above. Stoutenburg et al however fails to specifically teach the provider communications system being an IVR system.

With respect to claim 50, Karns et al teach users interacting with either a live voice or an interactive voice response (IVR) system in order to use the electronic payment system. (Paragraph 0007).

In view of Karns et al's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an IVR system for communicating between the merchant (user) and the provider as is taught by Karns et al. One would be motivated to use an IVR system in order for the phone company to have less expenses by needing fewer live operators or customer service representatives.

Allowable Subject Matter

8. Claims 12 and 39 are objected to as being dependent upon a rejected base claim and also objected to above, but would be allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claims.

The following is an examiner's for allowance: Stoutenburg et al teaches a method for automating a transaction request including selecting a keycard from

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among multiple keycards, the above identified prior art of record, taken alone, or in combination with any other prior art, fails to teach or fairly suggest the specific features of claims 12 and 39 of the present claimed invention. Prior art fails to teach the following: the customer selecting a dummy card and the merchant selecting a keycard associated with the dummy card; the merchant retaining the keycard after the delivering step; and the pro. Moreover, one of ordinary skill in the art would not have been motivated to come to the claimed invention.

Response to Arguments

9. Applicant's arguments, see pages 1-5 filed November 25, 2005, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Stoutenburg et al. It is believed that Stoutenburg et al's teachings above include the claimed limitations. Claims 12 and 39 are objected to as being dependent upon a rejected base claim, but are indicated to be allowable if rewritten in independent form. Stoutenburg et al simply teaches selecting a keycard from among multiple keycards and providing the customer with a transaction confirmation, which includes an associated PIN, however fails to teach either the customer selecting a dummy card and the merchant selecting a keycard associated with the dummy card, or the merchant retaining the keycard after the delivering step.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson N. Trail* whose telephone number is

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(571) 272-2406. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax phone number for this Group is (571) 273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [allyson.trail@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Allyson N. Trail
Patent Examiner
Art Unit 2876
February 2, 2006



KARL D. FRECH
PRIMARY EXAMINER